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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,174	10/23/2003	Benjamin N. Eldridge	P47C2-US	8347
50905	7590	08/06/2008		
N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			EXAMINER ABRAMS, NEIL	
			ART UNIT 2839	PAPER NUMBER
			NOTIFICATION DATE 08/06/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/692,174	Applicant(s) ELDRIDGE ET AL.	
	Examiner Neil Abrams	Art Unit 2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26,33,35 41,42,48,73-85,87,92,94,97-99 and 103-110 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) all claims in the case is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-11-2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The filling of a request for continued examination (RCE) is noted and a first action follows.

The declaration under 37 CFT 1.732 is objected to as the printed words are too light and difficult to read. Replacement copy is required .

Claim 35 on reconsideration included in the elected group, It should be redesignated in the next response

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 26, 33, 35, 41, 42, 48, 73-85, 87, 89-92, 94, 97-99, 103-110 (all claims in the case) are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6672875 to Mathieu in view of Cowie. and Germany 2753654

3. Mathieu claim 22 as example, includes contact on substrate having post, resilient beam and tip on the beam, but lacks recitation of tip being of palladium cobalt alloy.

4. Note Cowie column 2, line 29-39 use of palladium cobalt alloy for electrical parts, see inlay 14 and Germany uses palladium-cobalt alloy for electrical contacts, see title. It would have been obvious to use such material for the Mathieu contact or contact tip in view of these teachings for protection against oxidation. Note that in the last response applicant agreed to file a terminal disclaimer to avoid a double patenting rejection. Submission of the terminal disclaimer in the next response suggested to expedite the case

5. Claims 26-33, 35, 41, 42, 48, 73-85, 87, 98-92, 94, 97-99, 103-110 (all claims in the case) are rejected under 35 U.S.C. 103 as unpatentable over Fjelstad in view of Cowie 789, Germany, Shida, Yanof 430 and Feussner

6. For claims 26, 32, 41, Fjelstad figures 13, 14, discloses test probe card 300 having a probe contact 302 with base 306 resilient body 310 and tip 314, 324 mounted to the body and discloses that the tip may be palladium alloy, col 3, lines 60-65. Yanof not essential added only to show that palladium use is common for probe tips. Fjelstad does not disclose palladium cobalt alloy. Cowie discloses use of Palladium Cobalt alloy, for plating and for inlay 14 for reasons of high conductivity and to lessen oxidation. Shida uses palladium-cobalt alloy for layer 1, the cobalt to strengthen the

palladium. German patent and Feussner disclose use of palladium cobalt alloy for electrical contacts the cobalt to provide hardness. Obvious in view of these teachings to use such material for Fjelstad tip 314, 324 for same reasons as taught in secondary references. Use as test member disclosed by Fjelstad, col 5, line 50. For Claim 36, 73, part 310 forms a beam structurally distinct from base 306 at bend line 311. For claim 78, 85 Fjelstad discloses contact tips to be formed by electroplating Claim 82. Fjelstad tip and body are distinct structures. Claim 90 item to be tested cannot serve as basis for patentability. Claim 94, contact spacing deemed matter of obvious design depending on item to be tested. All dependent claims, not mentioned included in rejection, since it appears that only parent claims recitations of use of palladium-cobalt alloy feature are at issue as evidenced by arguments presented.

Claims 79 - 84, 105, 106, 108, 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faraci in view of Fjelstad, Yanof 430, Cowie, Shida, Germany, and Feussner.

Faraci test socket includes probe card 110 see fig 5B, 3D, 3C, with contacts having posts 170, beams 190 and tips 320 but lacks use of palladium cobalt alloy for tips.

Fjelstad, uses palladium alloy for tips, Yanof uses palladium for contact tips. Cowie, Shida, Germany, and Feussner use palladium-cobalt alloy. Obvious to use palladium or its alloy for tips as in Fjelstad and Yanof for good conductivity and to choose to use palladium cobalt alloy to provide strengthening, etc as in Cowie, Shida,

Germany and Feussner Yanof applied as above for disclosure that palladium is standard for probe contact tips

7. . Arguments submitted in last response no longer apply since new references applied . The arguments and affidavit submitted have been considered but do not overcome the rejection since Cowie, Germany etc clearly teach palladium- cobalt alloy to be useful for reasons that would be applicable to contacts tips of the Fjelstad and Faraci type. The applied patents indicate that palladium is a common material for electrical contacts and that the palladium in such use may be alloyed with metals such as cobalt where strengthening is desired . Shida is noted to provide a teaching of cobalt use to strengthen palladium col 3 lines 50-55 that is applicable independently of the three layer disclosure Also note that in spec pages 41, 43 and same pages in parent cases, use of palladium-cobalt is discussed as a matter of selection of materials with no indication that its use provided any special advantage or that it was arrived at through extensive testing . Applicant asked to discuss such aspect in the response . Applicant also asked if they agree that palladium- cobalt alloy for electrical contacts in general is well known in the prior art even apart from cited references

Any inquiry concerning this communication should be directed to Neil Abrams at telephone number 571-272-2089

/Neil Abrams/

Primary Examiner, Art Unit 2839

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